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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,368	02/12/2001	John E. Cronin	ipCG-508	4217

7590 10/28/2004

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EXAMINER	
MOONEYHAM, JANICE A	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/781,368	CRONIN, JOHN E.	
	Examiner	Art Unit	
	Jan Mooneyham	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *17 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the applicant's communication filed on June 17, 2004, wherein:

Claims 1-35 are currently pending;

Claims 12, 15-17, 20, and 26 have been amended;

Claims 28-35 have been added;

No claims have been cancelled.

Response to Amendment

Oath/Declaration

2. The applicant has submitted an amended oath/declaration and it has been entered into the record.

Drawings

3. The amended drawings were received on June 17, 2004. These drawings are acceptable.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 30-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicant claims "generating at least one invention map showing the at least one solution." How is this done?.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The terms "mess statements, data statements, and problem statements, seed" in claims 1-5, 12, 17 and 18 are indefinite because the specification does not clearly redefine the term.

6. Claims 1-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 17, 28, 30 34 and 35 contain the term "elements relating to the problem statements, mess statements and/or data statements." It is unclear what the term "elements" means.

What are the limitations? What are the limitations of problem-element-solution combinations?

What are the solutions to the limitations?

In claims 5 –11 and 19-21, the applicant states that the elements are randomly generated or are conceived by users as the result of a stimulus. What is the stimulus?

How are the elements randomly generated?

How are the elements conceived using visual, tactile or olfactory stimulus?

How does a solution become conceived using one element and a problem statement as a creative stimulus?

How is the solution stored in a manner which indicates its relationship to a problem and an element? How is this relationship determined.

In Claim 12, what is meant by a complete invention? What is meant by a seed of an invention? What are all limitation of the seed of an invention and what are all solutions to the limitations? What is IOD? Where do the solutions come from?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatton (US Patent No. 6,101,490) (hereinafter referred to as Hatton).

Hatton discloses a system and method for creating new ideas and solving problems (Fig. 5) which provides a computer processor programmed to accept input and provide output, requesting and accepting input comprising data, inputting data (Fig. 5 – problem statement, Fig. 7, receiving input statement, col. 1, lines 64-66, col. 7, lines 45-51), aggregating and storing the data (Fig. 5 Experience Databases, Fig. 7 – add new entry to plant data base, col. 4, lines 57-65,

col. 7, lines 15-20, col. 8, lines 16-19) and providing out displaying the aggregated data (Fig. 5, Answer, Fig. 7 – display result, col. 8, lines 16-19, col. 9, line 19 thru col. 10, lines 17, col. 13, lines 21-22 – possible solution to problem).

While Hatton discloses a computerized idea generator and problem solver (col. 1, lines 29-33), Hatton does not explicitly show the data to be a mess statement, a data statement relating to the mess statement, problem statements relating to the data statements, elements relating to the problem statements, mess statements and/or data statements, limitations of problem-element-solution combinations, solutions to the limitations and elements conceived using visual, tactile or olfactory stimulus. However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited or the claimed structure. The requesting and accepting input comprising data, the aggregating and storing said input data and providing output displaying aggregate input data would be preformed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentablility, see *In re Gulack,* 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983; *In re Lowry,* 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person or ordinary skill in the art to use data having any type of content because such data does not functionally relate to the steps or the structure of the method or apparatus claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

The Examiner takes Official Notice that it is old and well known to communicate via a telephone system having conference calling capabilities, in fact, we do it and have done it here for years at the USPTO.

The fact that the applicant is claiming a system and method for facilitating conception of inventions verses creating new ideas and solving problems adds little to the claimed structure or acts since this is language is in the preamble and also since this language is also directed to the intended use of the system and method. Hatton discloses a system comprising a computer processor (Fig. 5), data storage, and a display (user interface)

A computer processor is inherently a component of a server.

The fact that the computers are linked via a network selected from a group consisting of a local area network, the Internet or Intranet, or that there are one or more participant computers remotely located is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate any of these limitations into the system and method of Hatton since this is old and well known technology and would have been common knowledge to one having ordinary skill in the art.

8. Claims 30-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatton in view of Smith (US 5,662,478) (hereinafter referred to as Smith)..

Hatton discloses a method, medium and system of facilitation conception of at least one invention comprising the steps of:

(a) receiving at least one mess statement (Figure (The Mess));

(b) receiving at least one problem statement (col. 1, lines 57-60);

(c) receiving at least one solution (col. 4, lines 51-56, 63-65); and

Hatton does not disclose generating at least one invention map showing the at least one solution. However, Smith discloses generating at least one invention map showing the at least one solution (Figure).

It would have been obvious to one of ordinary skill in the art to incorporate into the disclosure of Hatton the teachings of Smith since the map reduces discord by providing a tool which enables the members of the group to estimate their present position in the flow process, because the process of generating problem solving ideas is very analogous to the expeditionary process.

Response to Arguments

9. Applicant's arguments filed Jun3 17, 2004 have been fully considered but they are not persuasive.

The applicant has argued against the rejection under 35 USC Section 112, Second Paragraph. The applicant argues that terms used throughout the present application are not uncommon terms in the relevant field of creative problem solving. The applicant points to US Patent 5,662,478 as evidence of this assertion. While Patent No. 5,662, 478 defines the term *mess* at column 4, lines 64-66, the applicant in the patent does not use this language in the claim language. Secondly, the fact that others have used a term does not mean that it has been clearly identified in this application. Furthermore, during examination, the claims must be interpreted as broadly as their terms reasonably allow. A claim must be interpreted in light of the specification without reading limitations into the claim. The applicant has failed to set forth the definition of the terms explicitly and with reasonable clarity, deliberateness, and precision. For example, on page 11 of the response, the applicant argues that a "mess statement" is a *positive,*

idealist stem. What does this mean? Furthermore, this definition is different from the definition in Patent 5,662,478, which is applicant's support his assertion that the definition of mess is not an uncommon term in the relative field.

On page 11 onto page 12, the applicant states that a "data statement" is "picture of the state of the art."

Applicant states on page 12 that ***generally*** the term *elements* are items applied to problem statements that stimulate creativity within participants to generate solutions to the problems contained in the problem statement.

As for the term "stimulus," the applicant states on page 13 that a stimulus is *something* that triggers a human cognitive process and maybe, ***e.g***. visual, tactile or olfactory matter. Exemplification is not an explicit definition.

Furthermore, if the applicant is claiming a step wherein the elements are randomly generated, this in not considered inconsequential to the patentability of the present claims.

Applicant states on pages 12 and 13 that the stimulus and the conception of a solution from a problem and an element is a human cognitive process. Applicant may not patent the human cognitive process.

Applicant's definition as to a complete invention, page 14, is unclear. Applicant states that by adding the term "IOD" it distinguishes a complete IOD invention form a complete invention generally. Applicant then states that a complete IOD Invention is a special case of a complete invention. Applicant then defines a complete IOD by stating that it is defined by a seed of an invention and all the corresponding solutions to all the limitations of the seed of an invention. This is indefinite.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the processor has to be specifically programmed to request problem statements that relate to data statements that relate to mess statements, that the system request that solutions be input, not output) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Once again, the applicant's argument that Hatton does not disclose facilitating conception by at least one participant, the applicant can not patent cognitive processes. It appears that all of the processes are done outside the computer and in a human brain with the computer only recording the data.

As for the nonfunctional descriptive data, the Examiner directs the applicant to the discussion in the rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM

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